

REMARKS

At the time of the Second Office Action dated November 12, 2008, claims 1, 9, and 13 were pending and rejected in this application. Claims 17-22 have been added, which correspond to originally-filed claims 2 and 4-8. Claims 23-25 have been added, which correspond to originally-filed claims 10-12. Claims 26-28 have been added, which correspond to originally-filed claims 14-16.

CLAIMS 1, 9, AND 13 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON PITRODA, U.S. PATENT NO. 5,884,271 (HEREINAFTER PITRODA)

On pages 2-4 of the Second Office Action, the Examiner asserted that Pitroda discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

As previously argued in the Amendment filed June 28, 2008 (hereinafter the First Response), Applicants recognize that Pitroda teaches a transaction memory area 410 that stores, in electronic form, transaction receipts (see column 12, lines 21-24; column 10, lines 30-32; column 11, lines 4-7, 24-26). Pitroda also describes that the transactions can be downloaded to a home/office PC or stored in a main central computer of the card company (column 12, lines 24-26; column 11, lines 7-9). However, with the exception of discussing that these transactions can later be analyzed, Pitroda discusses little else with regard to the receipts.

Referring to claims 9 and 13, absent from the Examiner's cited passages are teachings regarding (i) locating a specific electronic receipt stored within the data store which corresponds

1 to an identifier provided by the individual one of the multiple disparate vendors, and (ii)
2 transmitting the located specific electronic receipt to the individual one of the multiple disparate
3 vendors over the established communicative link. Also, although Pitroda teaches authenticating
4 the user of the UET card, the Examiner's cited passages fail to teach that the "individual one of
5 the multiple disparate vendors" is authenticated, as claimed. Claim 1 recites similar limitations
6 to those found in claims 9 and 13 and is patentable over Pitroda for similar reasons to those
7 presented above.

8
9 On pages 5 and 6 of the Second Office Action, the Examiner responded to Applicants'
10 arguments presented in the First Response as follows. Initially, the Examiner asserted:

11 Regarding Claims 1, 9, and 13, Applicant argues that Pitroda does not teach (i) *locating a specific*
12 *electronic receipt stored within the data store which corresponds to an identifier provided by the*
13 *individual one of the multiple disparate vendors*. Examiner respectfully disagrees. Pitroda teaches
14 storing all transaction receipts in electronic form and a database management system. Pitroda
15 further teaches a POS (point of sale, i.e. vendor) database includes ID numbers, service
16 numbers, or sales identifications (column 12, lines 21-32 and lines 60-67; Figure 2). A
17 database by definition is a collection of data organized in such a way that facilitates access or
18 retrieval of the data, among other things. Locating a specific piece of information in a database is
19 inherent. Therefore, Examiner maintains that Pitroda does anticipate this limitation.

20
21 The Examiner's reliance upon the doctrine of inherency is misplaced. Inherency may not be
22 established by probabilities or possibilities. The mere fact that a certain thing may result from a
23 given set of circumstances is not sufficient to establish inherency.¹ To establish inherency, the
24 extrinsic evidence must make clear that the missing element must necessarily be present in the
25 thing described in the reference, and that the necessity of the feature's presence would be so

¹ In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

1 recognized by persons of ordinary skill.² Furthermore, reference is made to ex parte Schricker,³
2 in which the Honorable Board of Patent Appeals and Interferences stated the following:

3 However, when an examiner relies on inherency, it is incumbent on the examiner to point to the
4 "page and line" of the prior art which justifies an inherency theory. Compare, In re Rijckaert, 9
5 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an
6 explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or
7 suggestion appears in the prior art); In re Yates, 663 F.2d 1054, 107, 211 USPQ 1149, 1151
8 (CCPA 1981).
9

10 The Examiner did not discharge the burden of indicating where such a teaching appears
11 in the prior art. As is readily apparent, the capability of "[l]ocating a specific piece of
12 information in a database" is not necessarily limited to that claimed, as there are many different
13 techniques that can be used to obtain information from a database. Thus, the Examiner has not
14 established that this limitation is inherently disclosed by Pitroda. In this regard, the Examiner is
15 also referred to M.P.E.P. § 2112, entitled "Requirements of Rejection Based on Inherency;
16 Burden of Proof."
17

18 The Examiner's analysis also neglects to consider that the identifier is provided by the
19 individual one of the multiple disparate vendors. Thus, even if the applied prior art uses an
20 identifier to retrieve information, such a teaching alone would not establish that the Pitroda
21 identically discloses all of the claimed limitations.
22

23 In the first full paragraph on page 6 of the Second Office Action, the Examiner further
24 asserted the following:

25 Applicant argues that Pitroda does not teach (ii) *transmitting the located specific electronic receipt*

² Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

³ 56 USPQ2d 1723, 1725 (BPAI 2000).

1 *to the individual one of the multiple disparate vendors over the established communicative link.*
2 Examiner respectfully disagrees. Pitroda teaches that after CIU software recognizes the UET card
3 contact, the CIU prepares itself *to read information* from the UET card (column 13, lines 1-8;
4 Figure 7). Figure 7 depicts the software for the CIU which explicitly teaches that the information
5 read from the card has been transmitted from I/O drivers (71) to the UET card management (75)
6 *CARD INFO. READ*. Therefore, Examiner maintains that Pitroda does anticipate this limitation.
7

8 Applicants recognize that the CIU software reads "information" from the UET card, but the
9 Examiner has failed to establish that Pitroda teaches that an electronic receipt is transmitted to an
10 individual one of the multiple disparate vendors. To be anticipatory, the Examiner must
11 establish that the applied prior art teaches all of the limitations, as claimed.
12

13 As discussed in column 14, lines 7-9 of Pitroda "security mechanisms can be built into
14 the UET card to avoid access to confidential information." Thus, Pitroda explicitly recognizes
15 that not all information found within the UET card should be accessible. Thus, the fact that
16 Pitroda teaches that some information can be transmitted does not identically disclose that a
17 particular type of information is transmitted.
18

19 In the last full paragraph on page 6 of the Second Office Action, the Examiner asserted
20 the following:

21 Applicant argues that Pitroda fails to teach *that the "individual one of the multiple disparate*
22 *vendors" is authenticated*. Examiner respectfully disagrees. Pitroda teaches *a previously*
23 *authorized service institution* (column 7, lines 30-35). The step of authorizing a service institution
24 or vendor or other business entity has been accomplished. The type of business entity authorized
25 or authenticated does not alter the step of authenticating or the structure of the system. Therefore,
26 such differences do not effectively serve to patentably distinguish the claimed invention over the
27 prior art. Examiner maintains that Pitroda does anticipate this limitation.
28

29 The Examiner's citation of "a previously authorized service institution" found in column 7, lines
30 33-34 is a gross misrepresentation of the applied prior art. What Pitroda actually teaches is
31 "selecting a previously authorized service institution account." By omitting the word "account"
32 from the Examiner's characterization of the prior art, the Examiner has significantly

1 misrepresented what Pitroda actually teaches. The authorization of an account is not the same as
2 the authenticating a vendor.

3

4 Therefore, for the reasons presented above, Applicants respectfully submit that the
5 imposed rejection of claims 1, 9 and 13 under 35 U.S.C. § 102 for anticipation based upon
6 Pitroda is not viable, and hence, Applicants solicit withdrawal thereof.

7

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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